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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,560	08/28/2003	Eric D. Fox	073897.0140	7600
5073	7590	07/08/2005	EXAMINER HENDERSON, MARK T	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/650,560

Applicant(s)

FOX, ERIC D.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-9, 15-17, 23, 31-33, 39 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 15-17, 23 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 39 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED OFFICE ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 7, 15, 16 and 23 have been amended. Claim 41 has been added. Claims 1-6, 10-14, 18-22, 24-30, 34-39 and 40 have been canceled.

### ***Response to Amendment***

2. After further review of the pending claims, the examiner has withdrawn the allowable subject matter of the previous office action and has submitted a new rejection below.

***Claim Objections***

3. Claim 31 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 31 depends on canceled claim 24. Please make appropriate corrections.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoonsbeen (4,878,073).

Hoonsbeen discloses in Fig. 1 and 2, an identification card and a method for securing an item comprising: a cavity (P) operable to receive an item (15); a slidable cover (20) operable to secure the item (P) in the cavity and to permit the item to be removably inserted from the cavity; a securing mechanism (11a and 20C) operable to affix the cover (20) to the card; wherein the

securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removably secure the cover (20) to the identification card, and a distal portion (20c) along the edge of the cover; a magnetic strip (25 and 26) operable to store information of the issuer of the card, and disposed on the card at a location separate from the location of the cavity; and wherein the card comprises a transparent face.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoonsbeen in view of Lam et al (5,546,144).

Hoonsbeen discloses in Fig. 1 and 2, an identification card comprising: a recess (P) operable to receive an insert (15); a slidable cover (20) operable to secure the item (P) in the cavity and to permit the item to be removably inserted from the cavity; a securing mechanism (11a and 20C) operable to affix the cover (20) to the card; wherein the securing mechanism comprises a groove or recessed portion (11a) in the cavity operable to removably secure the cover (20) to the identification card, and a distal portion (20c) along the edge of the cover; a

magnetic strip (25 and 26) operable to store information of the issuer of the card, and disposed on the card at a location separate from the location of the cavity; and wherein the card comprises a transparent face.

However, Hoonsbeen does not disclose wherein the insert is coupleable to a picture to permit the picture to be removably inserted from a recess.

Lam et al discloses in Fig. 4, an insert (56) coupleable to a picture (58) to permit the picture to be removably inserted from a recess (38) from card (20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hoonsbeen's card with an insert having a coupled picture as taught by Lam et al for providing a mounting platform in which to prevent movement of the inserted picture.

In regards to **Claim 23**, the method of the picture being personally selected by the cardholder to customize the identification card according to one or more particular personal preferences of the cardholder, does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious form a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would have been obvious to customize the cards in any desired manner.

***Allowable Subject Matter***

6. Claims 8, 9, 39 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Valdez et al, Minami et al, Miao, Rappaport et al, Andrews, Andrews et al, McIntire et al, Kamens et al, Hewitt and Reno disclose similar cards.

***Response to Arguments***

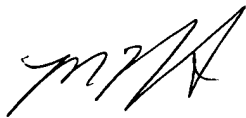
8. Applicant's arguments with respect to claims 7-9, 15-17, 23, 31-33, 39 and 41 have been considered but are moot in view of the new ground(s) of rejection.

The Hoonsbeen reference is now used to disclose a card having a cavity for insertion of an item; a securing mechanism; a transparent face; and a magnetic stripe.

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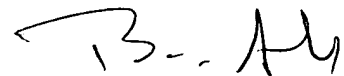
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The fax number for TC 3700 is (703) 872-9306.



MTH

July 1, 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER